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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

WM51/1025

ART UNIT STAMBER PAPER NUMBER

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DATE MAILED: 2163

10/25/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 6/5/00

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100+ is/are pending in the application. 106712

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) ALL OF THE ABOVE PENDING CLAIMS is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. This action is responsive to the amendment filed 6/5/2000. As per applicant's request, claims 76 and 95 have been amended, claims 1-36, 39, 41-46, 50, 52-56, 63-65, 67-70, 73, 74, 77, 80-82, 84, 85, 87-90, 93, 96, and 101-106 have been cancelled, and newly submitted claims 106-112 have been entered. Claims 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100, and 106-112 remain pending.

2. Applicant is requested to resend the Form PTO-1449 and accompanying references of the IDS filed 6/27/2000 as the only paper that is currently in the file is the cover sheet for the IDS. The examiner notes that there is no fee for this as the fee in lieu of certification has already been charged to the deposit account on 6/29/2000.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 66, 71, 72, 75, 78, 79, 83, 86, 91, 92, 94, and 97-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 66 and 86 are vague and indefinite as the body of the claim does not accomplish what the preamble sets forth. The preamble of each claim states "controlling a transaction at a point of sale location", however the steps (or means) in the body never perform ^{any} and aspect that may be considered control.

B. Claim 98 line 5, "means for customer information" is confusing as there is no action performed (i.e., receiving).

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C. Claims 71, 72, 75, 78, 79, 83, 91, 92, 94, 97, 99, and 100 are rejected as being dependent on claims discussed above.

5. Claims 38, 40, 57-59, 71, 72, 91, 92, 98, 107, 109, and 110 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims are related to the customer scrolling through a list of point of sale locations to enable the system to know the location of the terminal where they are transacting business. However the specification is wholly deficient on describing how an antenna or cell site knows the location of all of the stores in its area, let alone all of the point of sale terminals in all of those stores, in order to display a scrolling menu of the locations to the customer. Are all of the individual stores and all of the terminals in those stores supposed to register with the service? If so, this is clearly not described in the specification in order to enable one of ordinary skill in the art to practice these claims.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 66, 71, 72, 86, 91, and 92 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Independent claims 66 and 86 merely manipulates abstract ideas without limitation to a practical application in the useful arts. An act such as “charging” as in claim 75 or “transmitting” as in claim 37 needs to be recited in order to have such a practical application.

8. Due to the ambiguity of the claims, they were interpreted as best as possible by the examiner for the purpose of the following examination.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 37, 38, 40, 47-49, 51, and 57-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao et al. (US 5,878,337).

A. As per claim 37, Joao et al discloses a method for controlling financial transactions using a wireless network comprising: determining transactions amounts at point of sale locations (as in all point of sale terminals, the point of sale terminal 2 of Joao et al. will “ring-up” the individual items of the purchase and display a total amount); transmitting said transaction amounts over said wireless network to wireless devices (step 37 in Fig. 3 discussed in column 18 lines 22-44); displaying said transaction amounts for customers using said wireless devices (step 38 in Fig. 3 discussed in column 18 lines 45-56; additionally it should be noted that the point of sale terminal

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itself will display the transaction amount when it is done computing the total of the items “rung-up”); and completing said transactions by charging said transaction amounts to sources of funds identified by said customers (at least step 53 in Fig. 3 discussed in column 19 lines 64-67 with the card that has been “swiped” in step 31 being the source of funds).

As per claim 49, this is the apparatus version of the above discussed method claim and is rejected based on the same analysis with the exception of the last “means” where the means for determining whether a particular customer has verified said financial data received by said customer’s wireless device being shown by Joao et al. in at least steps 39, 40, and 46 in Fig. 3 discussed from column 18 line 57 to column 19 line 50).

B. As per claims 38 and 57, Joao et al. discloses identifying said point of purchase location in column 18 lines 31-44.

C. As per claims 40, 58 and 59, Joao et al. discloses that the customers select said point of sale locations using a series of menus displayed on the display device in column 20 lines 18-30 (note the description is a scrolling series of transactions representing account activity and by scrolling through the transactions you are “selecting” the location because, as has already been established in claims 38 and 57, the location is one of the many items included with the message sent to the wireless device).

D. As per claims 47 and 48, Joao et al. discloses that the source of funds is either preselected before the transaction occurs (which equates to the customer getting their credit card

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out of their wallet before any item is rung up) or during the transaction (which equates to the customer getting their credit card out of their wallet while the item is rung up).

E. As per claim 51, Joao et al. discloses that the informing means comprises a voice message in at least column 14 lines 51-65 (note that any of the telephone or telephone answering machine embodiments inherently comprise a medium that delivers a voice message).

F. As per claims 60-62, the determination of a geographic location of the customer, by cell site or antenna, is inherent in wireless/cellular networks.

11. Claims 37, 38, 40, 47-49, 51, 57-62, 66, 71, 72, 75, 76, 78, 79, 83, 86, 91, 92, 94, 95, 97-100, and 106-112 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Vazvan (WO 97/45814), as cited by applicant.

See the entire detailed description beginning on page 4 (and the related drawing figures) in which Vazvan discloses what is called a Mobile Wallet-Phone (MWP) which the examiner submits reads on the instant invention as presently claimed. It should be noted that this analysis is based on claims which have numerous problems (35 USC 101, 112 first and second paragraph) as discussed above.

12. Applicant's arguments filed 6/5/2000 have been fully considered but they are not persuasive.

Applicant attempts to contrast the instant invention from that in Joao et al. on pages 10-14 of the 6/5/2000 response.

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Applicant first states in general that “in the present invention, transactions are initiated and completed by customers using a single wireless device, such as a cellular telephone.” The examiner submits that such “initiation” by a customer via a wireless device is not a limitation in the any of the independent claims. Claim 107 comes the closest, however the examiner submits that in that instance it is unclear from the claim whether it is the locating which is performed based on the wireless device, or the initiating. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., initiation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant next states that “claim 40 requires the limitation that ‘customers select said point of sale locations using a series of menus displayed on said wireless devices.’” The examiner submits that applicant is reading entirely too much into this simple claim limitation and that the limitation reads on the fact that the user of Joao et al. can scroll through the account transactions (column 20 lines 18-30) which also include information concerning the location (column 18 lines 31-44); i.e., the customer can “identify” the location based on the information in the account transaction.

Applicant next states that “claim 51 requires a means for informing customers of communicated financial data ‘wherein said informing means comprises a voice message.’” The examiner submits that Joao et al. describes many different “communications means 4” and that any

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of the telephone or telephone answering machine embodiments, which are clearly described as options of the "communications means 4", inherently comprise a medium that delivers a voice message.

Applicant next states again that "claim 59 requires 'using menus displayed on said wireless telephones' to identify point of sale locations." This limitation has already been discussed in regard to claim 40 above.

Applicant next states that "claims 60-62 include the feature of determining the geographic location of a customer. Applicant traverses the Examiner's rejection of claims 60-62 under 35 USC 103(a), wherein the Examiner suggests that it would have been obvious to use wireless network locating information." The examiner submits instead that it is inherent in wireless/cellular networks for the cell site or antenna to identify the location of the wireless device with which it is communicating. This location is identified, in its most simple sense, as the location of the cell site or antenna that is communicating to the wireless device, clearly a geographic location. The examiner also submits that in a broad reading of Joao et al., that the customer is the one with the credit card, and that he is clearly identified by the location of the point of sale terminal (column 18 lines 31-44), thus at least claim 60 is clearly rejectable.

From the above discussion it should be clear that applicant is reading *entirely too much* of the specification into the claims, and that they are broad enough, based on the broadest reasonable interpretation of the claims, to read on the Joao et al. reference. Applicant has a very detailed procedure, as described in the specification, *which they have not begun to claim*. Additionally,

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applicant should carefully review the references which the examiner newly cited on the Form PTO-892 as they are very relevant and applicant could unwittingly amend the instant claims into this prior art.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Stamber whose telephone number is (703) 305-8469. The examiner can normally be reached Monday-Thursday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at (703) 305-9643.

The fax number for Technology Center 2100 is (703) 308-9051 or 9052.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

EWS
October 20, 2000



Eric W. Stamber
Primary Examiner
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